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EXAMINER

NGUYEN, DUSTIN

ART UNIT

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2154

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/605,572	Applicant(s) KELLEY ET AL.	
	Examiner DUSTIN NGUYEN	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-21,23-41,43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-21,23-41,43 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 3, 21, 23-41, 43 and 44 are presented for examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/12/2008 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-6, 21, 23-26, 41, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniell et al. [US Patent Application No 2004/0054736], in view of Boyer et al. [US Patent No 7,336,779].

5. As per claim 1, Daniell discloses the invention as claimed including a method for providing interoperability of email and instant messaging services [i.e. system and method for integrating Instant Messenger (IM) services and email services] [Abstract; and paragraphs 0004 and 0008], comprising:

receiving a request by an email recipient to respond to an email message using an instant message application [i.e. the IM Start button permits a user to launch an IM session with various contact from the read window] [Figure 10; and paragraphs 0006 and 0089], said email message received from an email sender [i.e. the sender's email address is extracted from the email message] [Figure 9; and paragraph 0073];

retrieving an instant message address for said email sender from storage [i.e. retrieve IM information from the address book database] [Abstract; and paragraphs 0009 and 0075];

associating said instant message address of said email sender with an instant message composed by said email recipient [i.e. the IM address associated with the extracted email address is retrieved from the address book database] [Figures 13A and 13B; and paragraphs 0074 and 103-107];

transmitting said instant message to said instant message address using said instant message application [i.e. launch an IM chat session with email contact or IM Start button] [1050, Figure 10; paragraphs 0076, 0089 and 0091];

wherein an email address associated with said email sender is mapped to a corresponding instant message address associated with said email sender [i.e. the address book object generates a query to the address book database to request all IM addresses that are correlated to the extracted email addresses] [502, 504, Figure 5; Abstract; and paragraphs 0009 and 0074].

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Daniell does not specifically disclose

transmitting history data along with said instant message, said history data including communications exchanges previously conducted between said email recipient and said email sender; wherein said communications exchanges include at least one of: email messages; instant messages; and attachments.

Boyer discloses

transmitting history data along with said instant message, said history data including communications exchanges previously conducted between said email recipient and said email sender [i.e. providing the transcript of the session to the customer] [col 10, lines 65-col 11, lines 3; and col 20, lines 54-56]; wherein said communications exchanges include at least one of: email messages; instant messages; and attachments [col 2, lines 33-35; and col 16, lines 10-17].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Daniell and Boyer because the teaching of Boyer on providing the transcript would enable to monitor and maintain proper communication information between users.

6. As per claim 3, Daniell discloses determining whether said email sender is available to receive said instant message [i.e. IM Internet presence information of the contacts at the extracted email address] [paragraph 0073]; if available, sending a notification of successful transmission to said email recipient [i.e. if the extracted email address is found in the address book database] [paragraphs 0074 and 0075]; and if not available, querying said email

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recipient to perform at least one of: storing said instant message and periodically retransmitting said instant message; aborting said instant message; and transferring content of said instant message to an email application resulting in an email message and transmitting said email to said email sender [i.e. generate an error message if no IM Internet presence information is available for that extracted email address] [paragraphs 0074 and 0075].

7. As per claim 4, Daniell discloses wherein said content includes: message text; recipient addresses; sender addresses; and history data [i.e. chat window] [Figures 6 and 15; and paragraphs 0079 and 0109].

8. As per claim 5, Daniell discloses wherein said history data is stored on both of said email recipient's and said email sender's storage systems [paragraphs 0121, 0124 and 0136].

9. As per claim 6, Boyer discloses receiving a request by an instant message recipient to respond to an instant message using an email application; retrieving an email address for an instant message sender from storage; associating said email address of said instant message sender with an email message composed by said instant message recipient; and transmitting said email message to said email address using said email application; wherein an instant message address associated with said instant message sender is mapped to a corresponding email address associated with said instant message sender [i.e. mix mode between real time and non real time modes] [col 6, lines 10-17]; transmitting additional history data along with said email message; said additional history data including communications exchanges previously

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conducted between said instant message recipient and said instant message sender [i.e. providing the transcript of the session to the customer] [col 10, lines 65-col 11, lines 3; and col 20, lines 54-56]; wherein said communications exchanges previously conducted between said instant message recipient and said instant message sender include at least one of: email messages; instant messages; and attachments; and sending a notification of successful transmission to said instant message recipient [col 2, lines 33-35; and col 16, lines 10-17].

10. As per claims 21, 23-26, they are rejected for similar reasons as stated above in claims 1, 3-6.

11. As per claim 41, it is rejected for similar reasons as stated above in claim 1. Furthermore, Daniell discloses a host system executing an integrated message system [i.e. servers] [paragraphs 0083 and 0148]; a link to a first client system client system associated with an email sender, said first client system executing a first email application and a first instant message application; a link to a second client system associated with an email recipient, said second client system executing a second email application and a second instant message application [i.e. IM user agent and email user agent] [Figure 1; and paragraphs 0006, 0045, 0046, 0111 and 0116].

12. As per claim 43, Daniell discloses a notification of successful transmission transmitted to said email recipient if said email sender is determined to be available to receive said instant message by said integrated messaging system [paragraph 0040].

13. As per claim 44, Daniell discloses a new email message generated by said integrated message system [i.e. option to compose a new message] [paragraph 0071]. Daniell does not specifically disclose wherein content of said instant message is transferred to said new email message within an email application operable for transmitting said new email message to said email sender; wherein said new email message is generated in response to a request by said email recipient upon unavailability of said email sender to receive said instant message. Boyer discloses wherein content of said instant message is transferred to said new email message within an email application operable for transmitting said new email message to said email sender; wherein said new email message is generated in response to a request by said email recipient upon unavailability of said email sender to receive said instant message [i.e. change contact mode] [col 15, lines 61-col 16, lines 17]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Daniell and Boyer because the teaching of Boyer would enable the contact server to manipulate media types associated with customers and to convert mode or media types to a common denominator to facilitate a session [Boyer, col 16, lines 3-9].

14. Claims 7-12, and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniell et al. [US Patent Application No 2004/0054736], in view of Boyer et al. [US Patent No 7,336,779], and further in view of Danon [US Patent Application No 2003/0110211] and Davis et al. [US Patent Application No 2004/0158610].

15. As per claim 7, Daniell discloses deploying process software for providing said interoperability of email and instant messaging services [i.e. software modules are installed] [paragraphs 0046, 0047, 0053 and 0137]. Daniell and Boyer do not specifically disclose deploying comprising: installing said process software on at least one server; identifying server addresses for users accessing said process software on said at least one server; sending said process software to said at least one server and copying said process software to a file system of said at least one server; sending the process software to at least a first client computer; and executing said process software on said first client computer. Danon discloses deploying comprising: installing said process software on at least one server; identifying server addresses for users accessing said process software on said at least one server; sending said process software to said at least one server and copying said process software to a file system of said at least one server [i.e. user can receive client component by accessing a predetermined Internet site] [paragraphs 0017 and 0046]; sending the process software to at least a first client computer; and executing said process software on said first client computer [i.e. the client component is transmitted to the user's computing device] [paragraphs 0017 and 0027]. Daniell, Boyer and Danon do not specifically disclose installing a proxy server if needed. Davis discloses installing a proxy server if needed [i.e. deploy client proxy instant messaging] [Abstract; and paragraphs 0006, 0024 and 0025]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Daniell, Boyer, Danon and Davis because it would enable to provide interoperability between various protocols for client device [Davis, paragraph 0079].

16. As per claim 8, Danon discloses wherein said installing said process software further comprises: determining if programs will reside on said at least one server when said process software is executed; identifying said at least one server that will execute said process software; and transferring said process software to storage for said at least one server [i.e. web and email servers] [Figure 1; and paragraphs 0042-0045].

17. As per claim 9, Danon discloses wherein said sending said process software to said first client computer further includes having said at least one server automatically copy said process software to said first client computer, and running an installation program at said first client computer to install said process software on said first client computer [i.e. client software is installed on user's computing device] [paragraphs 0003 and 0065].

18. As per claim 10, Danon discloses wherein said sending said process software to said first client computer further comprises identifying a user and an address of said first client computer [i.e. identifying recipient] [paragraphs 0045 and 0045; and claim 4].

19. As per claim 11, Danon discloses wherein said sending said process software to said first client computer includes sending said process software to at least one directory on said first client computer [i.e. user temporary storage on local hard drive] [paragraph 0018].

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20. As per claim 12, Danon discloses wherein said sending said process software to said first client computer includes sending said process software to said first client computer via e-mail [paragraph 0049].

21. As per claim 27, it is rejected for similar reasons as stated above in claim 7. Furthermore, Danon discloses identifying said at least one server that will execute said process software and transferring said process software to storage for said at least one server [paragraphs 0042 and 0043].

22. As per claims 28-32, they are rejected for similar reasons as stated above in claims 8-12.

23. Claims 13 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniell et al. [US Patent Application No 2004/0054736], in view of Boyer et al. [US Patent No 7,336,779], and further in view of Danon [US Patent Application No 2003/0110211].

24. As per claim 13, Daniell and Boyer do not specifically disclose integrating process software for providing said interoperability of email and instant messaging services, said integrating comprising: determining if said process software will execute on at least one server; identifying an address of said at least one server; checking said at least one server for operating systems, applications, and version numbers for validation with said process software, and identifying any missing software applications for said at least one server that are required for

integration; updating said at least one server with respect to any operating system and application that is not validated for said process software, and providing any of said missing software applications for said at least one server required for said integration; identifying client addresses and checking client computers for operating systems, applications, and version numbers for validation with said process software, and identifying any software applications missing from said client computers that are required for integration; updating said client computers with respect to any operating system and application that is not validated for said process software, and providing any missing software application for said client computers required for said integration; and installing said process software on said client computers and said at least one server. Danon discloses integrating process software for providing said interoperability of email and instant messaging services, said integrating comprising: determining if said process software will execute on at least one server; identifying an address of said at least one server; checking said at least one server for operating systems, applications, and version numbers for validation with said process software, and identifying any missing software applications for said at least one server that are required for integration; updating said at least one server with respect to any operating system and application that is not validated for said process software, and providing any of said missing software applications for said at least one server required for said integration; identifying client addresses and checking client computers for operating systems, applications, and version numbers for validation with said process software, and identifying any software applications missing from said client computers that are required for integration; updating said client computers with respect to any operating system and application that is not validated for said process software, and providing any

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missing software application for said client computers required for said integration; and installing said process software on said client computers and said at least one server [i.e. determine if new and revive client component is available, checking for new version and update itself] [paragraph 0027]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Daniell, Boyer and Danon because the teaching of Danon would provide a method and system of communicating content between and among computing devices in a manner that reduces bandwidth and storage size requirements [Danon, paragraph 0006].

25. As per claim 33, it is rejected for similar reasons as stated above in claim 13.

26. Claims 14-18 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniell et al. [US Patent Application No 2004/0054736], in view of Boyer et al. [US Patent No 7,336,779], and further in view of Atencio et al. [US Patent Application No 2004/0210450].

27. As per claim 14, Daniell and Boyer do not specifically disclose on demand sharing of process software for providing said interoperability of email and instant messaging services, said on demand sharing comprising: creating a transaction containing unique customer identification, requested service type, and service parameters; sending said transaction to at least one main server; querying said at least one main server about processing capacity

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associated with said at least one main server to help ensure availability of adequate resources for processing of said transaction; and allocating additional processing capacity when additional capacity appears needed to process said transaction, said additional processing capacity being selected from the group of additional capacities consisting of central processing unit capacity, processor memory capacity, network bandwidth capacity, and storage capacity. Atencio discloses on demand sharing of process software for providing said interoperability of email and instant messaging services, said on demand sharing comprising: creating a transaction containing unique customer identification, requested service type, and service parameters; sending said transaction to at least one main server; querying said at least one main server about processing capacity associated with said at least one main server to help ensure availability of adequate resources for processing of said transaction; and allocating additional processing capacity when additional capacity appears needed to process said transaction, said additional processing capacity being selected from the group of additional capacities consisting of central processing unit capacity, processor memory capacity, network bandwidth capacity, and storage capacity [i.e. service configuration checks a capacity validation process to make sure that the infrastructure can handle new digital video stream] [paragraphs 0027 and 0053-0060]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Daniell, Boyer and Atencio because the teaching of Atencio would provide components for controlling service management, account management and device management for facilitating the self-provisioning of services by a subscriber, or plurality of subscribers of communications and/or media services [Atencio, paragraph 0002].

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28. As per claim 15, Atencio discloses recording a plurality of usage measurements selected from the group of usage measurements consisting of network bandwidth, processor memory, storage, and central processing unit cycles [i.e. bandwidth] [paragraphs 0008 and 0100].

29. As per claim 16, Atencio discloses summing said usage measurements; acquiring at least one multiplicative value associated with said usage measurements and with unit costs; and recording any such acquired multiplicative value as an on demand charge to a requesting customer [i.e. charge and billing process] [paragraphs 0026, 0034 and 0044].

30. As per claim 17, Atencio discloses at least one of: posting said on demand charge on a web site if requested by said requesting customer; and sending said on demand charge via e-mail to said requesting customer's e-mail address [i.e. account management] [paragraphs 0045-0052].

31. As per claim 18, Atencio discloses charging said on demand charge to said requesting customer's account if an account exists and if said requesting customer has selected a charge account payment method [i.e. setup billing account and payment method] [paragraphs 0045-0052].

32. As per claims 34-38, they are rejected for similar reasons as stated above in claims 14-18.

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33. Claims 19, 20 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniell et al. [US Patent Application No 2004/0054736], in view of Boyer et al. [US Patent No 7,336,779], and further in view of Roskind [US Patent Application No 2004/0128540].

34. As per claim 19, Daniell and Boyer do not specifically disclose deploying, accessing, and executing process software for providing said interoperability of email and instant messaging services, said deploying, accessing, and executing process software implemented through a virtual private network, the method further comprising: determining if a virtual private network is required; checking for remote access to said virtual private network when it is required; if said remote access does not exist, identifying a third party provider to provide secure, encrypted connections between a private network and remote users; identifying said remote users; and setting up a network access server operable for downloading and installing client software on desktop computers for remote access of said virtual private network; accessing said process software; transporting said process software to at least one remote user's desktop computer; and executing said process software on said at least one remote user's desktop computer.

Roskind discloses deploying, accessing, and executing process software for providing said interoperability of email and instant messaging services, said deploying, accessing, and executing process software implemented through a virtual private network [130, Figure 1; and paragraph 0036], the method further comprising: determining if a virtual private network is required; checking for remote access to said virtual private network when it is required; if said remote access does not exist, identifying a third party provider to provide secure, encrypted connections between a private network and remote users; identifying said remote users; and

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setting up a network access server operable for downloading and installing client software on desktop computers for remote access of said virtual private network; accessing said process software; transporting said process software to at least one remote user's desktop computer; and executing said process software on said at least one remote user's desktop computer [Figures 5 and 6; and paragraphs 0056-0060]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Daniell, Boyer and Roskind because the teaching of Roskind would provide a secured communication path that allows two separate networks or client devices to be connected over a WAN without exposing transmitted data to viewing by unauthorized parties [Roskind, paragraph 0036].

35. As per claim 20, Roskind discloses determining if said virtual private network has a site-to-site configuration for providing site-to-site access, and if said virtual private network is not so available, installing equipment required to establish a site-to-site configuration for said virtual private network; installing large scale encryption into said site-to-site virtual private network; and accessing said process software through said site-to-site configuration with large scale encryption [paragraphs 0061-0064].

36. As per claim 39, it is rejected for similar reasons as stated above in claim 19.

37. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Daniell et al. [US Patent Application No 2004/0054736], in view of Boyer et al. [US Patent No 7,336,779],

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and further in view of Roskind [US Patent Application No 2004/0128540] and Weiss [US Patent No 6,930,598].

38. As per claim 40, it is rejected for similar reasons as stated above in claim 20.

Furthermore, Daniell, Boyer and Roskind do not specifically disclose dialing into said network access server; and attaching directly via a modem into said network access server, said modem being selected from the group of modems consisting of telephone dial-up modems, cable modems, DSL modems and wireless modems. Weiss discloses dialing into said network access server; and attaching directly via a modem into said network access server, said modem being selected from the group of modems consisting of telephone dial-up modems, cable modems, DSL modems and wireless modems [col 7, lines 30-col 8, lines 9; and col 13, lines 38-40]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Daniell, Boyer, Roskind and Weiss because the teaching of Weiss would provide a variety of network services to computers and other devices both within the home and connected through the Internet [Weiss, paragraph 0001].

39. Applicant's arguments with respect to claims 1, 3-21, 23-41, 43 and 44 have been considered but are moot in view of the new ground(s) of rejection.

40. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Dustin Nguyen/
Primary Examiner, Art Unit 2154